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EXAMINER	
HOANG, HIEU T	

ART UNIT	PAPER NUMBER
2452	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/776,293	STEWART, BRETT B.	
	Examiner	Art Unit	
	HIEU T. HOANG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-169* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-169* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/11/04, 02/04/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communication filed on 02/11/2004.

2. Claims 1-169 are pending and presented for examination.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-169 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,835,061 ('061). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters in the two applications both involve identifying a client device's geographic location at an access point (current application, e.g., claim 6 and '061, e.g., claim 2), and transmitting information to the device depending on the geographic location of the device (current application, claim 1 and '061, claim 1). '061 further discloses using user ID for identifying the device (claim 1), whereas the current application claims identifying a user when establishing connection to a access point (claim 30) or using demographic information. Using user ID for identifying a user device would have been an obvious modification to one skilled in the art at the time of the invention.

5. Claims 1-169 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,969,678 ('678). Although the conflicting claims are not identical, they are not patentably distinct

from each other because they both involve identifying a client device's geographic location at an access point (current application, e.g., claims 1 and 6 and '678, e.g., claim 2), and transmitting information to the device depending on the geographic location of the device (current application, claim 1 and '678, claim 1). '678 further discloses using user IDs for identifying users and wired and wireless access points (claim 1), whereas the current application claims identifying a user when establishing connection to an access point (claim 30) or using demographic information. Using user IDs for identifying users and wired and wireless access points would have been an obvious modification to one skilled in the art at the time of the invention, since an access point can be wired and wireless, as known in the art.

6. Claims 1-169 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-108 of U.S. Patent No. 6,326,918 ('918). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both involve identifying a client device's geographic location at an access point (current application, e.g., claim 1 and '918, e.g., claim 1), and transmitting information to the device depending on the geographic location of the device (current application, claim 1 and '918, claim 1). '918 further discloses using user ID for identifying users and past transactions of the user (claim 1), whereas the current application claims identifying a user when establishing connection to an access point (claim 30, 33, 40) or using demographic information. Using user ID for identifying a user

and past transactions would have been an obvious modification to one skilled in the art at the time of the invention.

7. Claims 1-169 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,697,018 ('018). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both involve identifying a client device's geographic location (current application, e.g., claim 1 and '018, e.g., claim 1), and transmitting information to the device depending on the geographic location of the device (current application, claim 1 and '018, claim 1)

8. Claims 1-169 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 170, 172-173, 177-178, 180-182, 184-213 of copending Application No. 11/391,631 as of 01/22/2009 (hereafter '631). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters in the two applications both involve identifying a client device's location at a wireless access point (WAP) (current application, claim 1 and '631, claim 170), and sending information to the client device (current application, claim 1) or advertisement related to the WAP or a brand of the WAP provider to the client device ('631, claim 170). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 70-77, 92-110 are rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter. A carrier medium for carrying signals is non-statutory subject matter under 35 U.S.C 101 for it is not a process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 44, 17, 37, 49, 67, 73, 98, 107, 108, 124, 137, 149, 161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For claim 44, the examiner cannot find any disclosure in the specification regarding the content indicates a route from the geographic location of the computing

device to the destination. Claims 17, 37, 49, 67, 73, 98, 107, 108, 124, 137, 149, 161 are rejected for the same rationale.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 63-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 63 recites "the portable computing device" which lacks antecedent basis. Applicant is requested to fix similar deficiencies in the remaining claims. Correction is required.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 43, 46, 50, 54, 55, 59, 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (US 5,485,163, hereafter Singer).

17. For claim 63, Singer discloses a method of using geographic locations of one or more access points to service one or more users who are in a vicinity of the one or more access points, the method comprising:

a computing device establishing a connection with one of the one or more access points (fig. 1, abstract, access points 20, 22, 24, handheld device 6 or portable device on user 4, fig. 2, steps 64-68, col. 4, l. 19-32, signaling between personal locator unit PLU and an access point);

providing a geographic location of said one of said one or more access points to an information provider after said establishing (col. 4 l. 19-22, location of the base station BTS or access point is forwarded to the HLR—home location register);

receiving information from the information provider, wherein the information is dependent upon the geographic location of said one of said one or more access points; and transmitting the information to a portable computing device through said one of said one or more access points, wherein the information is transmitted to a computing device (fig. 2 step 72, HLR sends back formatted information (col. 2 lines 39-42) based on the location information to a subscriber's device, via the access point).

Singer does not disclose that the two devices are one.

However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to incorporate the two devices in order to provide location services to the PLU wearer with a single device and to make devices less cumbersome.

18. Claim 43 is rejected for the same rationale as in claim 63.

19. For claim 54, Singer further discloses the computing device is a portable computing device (fig. 1, col. 4 l. 39-40, cell phone).

20. For claim 55, Singer further discloses the geographic location of the computing device comprises a geographic location of the first access point; wherein the content is dependent upon the geographic location of the first access point (col. 4 l. 19-47, fig. 2, location of the BTS and formatted location content sent to user).

21. For claim 59, Singer further discloses the geographic location of the first access point is determined by its proximity to another geographic location (fig. 2, step 70, find location of access point, col. 4 l. 19-47, proximity geographic location of a BTS, col. 4 l. 47-55, proximity to another BTS).

22. For claim 60, Singer further discloses said transmitting includes the information provider transmitting the information through a network (fig. 1, 2, HLR sends information through a network).

23. For claim 61, Singer further discloses said transmitting includes transmitting the information through the first access point (fig. 1, 2, information sent from HLR to access point).

24. For claim 62, Singer further discloses the network includes one or more of a local area network and a wide area network (fig. 1, wide area network).

25. For claim 46, Singer does not explicitly disclose said establishing includes identifying a user of the computing device; wherein the content is dependent upon said identifying the user. However, Singer discloses identifying a computing device; wherein the content is dependent upon said identifying (col. 3 lines 1-5, device identifier). It would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to provide content services based on user identifier instead of device ID, or can even use device ID as a user ID for providing content.

26. Claim 50 is rejected for the same rationale as in claim 46.

27. Claims 44, 45, 47-49, 51-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Singer, in view of Muffat et al. (European Cooperation on Dual Mode Route Guidance-Perspectives for Advanced Research Partners, hereafter Muffat, cited in IDS).

28. For claim 44, Singer does not disclose receiving a destination; wherein the content indicates a route from the geographic location of the computing device to the

destination. However, Muffat discloses using beacons for calculating and providing routes to destination a user device (p. 930, left col., route computation using infrastructure side). It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and Muffat to provide navigation service to a user device.

29. For claim 45, Singer does not disclose the content includes weather information. However, Muffat discloses the same (p. 933, fig. 3, ice on road). It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and Muffat to provide weather report service to a user device.

30. For claim 47, Singer-Muffat further discloses said identifying the user indicates a profile of the user; wherein the content is dependent on the profile of the user (Muffat, p. 930, par 5, in the first case, user profile is individual criteria, par 6, user profile is previous route computation).

31. For claim 48, Singer-Muffat further discloses said identifying the user indicates past transactions of the user; wherein the content is dependent on the past transactions of the user (Muffat, p. 930, par 5, in the first case, individual criteria or past transactions, par. 6, user past route computation).

32. For claim 49, Singer-Muffat further discloses wherein said identifying the user indicates a profile of the user; wherein the profile of the user indicates the content is desired by the user (Muffat, p. 930, par. 5 and 6, criteria desired by a user).

33. For claims 51-53, the claims are rejected for the same rationale as in claims 47-49 respectively.

34. Claims 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer, in view of what was known in the art (Official Notice or ON).

35. For claim 56, Singer does not disclose said determining includes using a management information base (MIB), wherein the MIB comprises information including the geographic location of the first access point. Singer discloses using a lookup table (memory) for location determining (col. 4 l. 29) .However, Official Notice is taken that it was known in the art at the time of the invention to use a MIB for storing information. It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and ON to provide services to a user device using a MIB to manage information of devices efficiently and conform to SNMP standards.

36. For claim 57, Singer-ON further discloses the access point includes a memory comprising information of the MIB, wherein the memory comprises information including the geographic location of the access point (ON, MIB, Singer, col. 4 l. 29, lookup table).

37. For claim 58, Singer-ON further discloses said determining includes the computing device querying the first access point and the first access point responding to the querying with the geographic location of the computing device; wherein said providing includes the computing device providing the geographic location of the computing device (Singer, col. 4 l. 4-47, location information sent from BTS to the device).

38. Claims 1-42, 64-169 contain substantially the same subject matter in claims 43-63 and are therefore rejected by the same rationale. Other services including providing a map, a promotion, hotel etc. are disclosed by Muffat (fig. 3)

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is included in form PTO 892.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HH

/DUYEN DOAN/

Examiner, Art Unit 2452